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09/922,232	08/03/2001	Samuel Sergio Tenenbaum	2875/1G342-US1	7566

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/922,232

Applicant(s)

TENENBAUM, SAMUEL SERGIO

Examiner

Stephen M Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-52 and 58-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-52 and 58-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15 & 18.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Rejections - '35 USC § 112***

Claims 1-52 and 58-67 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification such that the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. Those claims contain the features of introducing or displaying a multimedia animated character into a computer screen and selecting a character, greeting, recipient and message. Those features are considered non-enabling because the recited "changing image which appears on screen intrusively in a manner which is unpredictable for a user and which is completely beyond user control" are not claimed such that one skilled in the art would be able to make or use the invention. That recitation claimed is given the broadest reasonable interpretation consistent with the specification, however the recited feature claimed involves subjectivity, which is considered non-enabling to those skilled in the field of endeavor of applicant's invention. The subjective terms "intrusively," "unpredictable," and "completely beyond user control" are interpreted in light of the specification but do not provide full, clear, concise, and exact term limitation such that the claimed invention is enabling. However, in order to consider these claims in light of the prior art, examiner will assume that these features are enabling by the specification.

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Claims 1-52 and 58-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Those claims contain the features of introducing or displaying a multimedia animated character into a computer screen and selecting a character, greeting, recipient and message. Those features are considered indefinite because the recited "changing image which appears on screen intrusively in a manner which is unpredictable for a user and which is completely beyond user control" are not claimed such that the features particularly point out and distinctly claim the subject matter which applicant regards as the invention. That recitation claimed is given the broadest reasonable interpretation, however the recited feature claimed involves subjectivity, which is considered indefinite to those skilled in the field of endeavor of applicant's invention. The subjective terms "intrusively," "unpredictable," and "completely beyond user control" are interpreted to many different degrees. What may be intrusive to one might not be so for another (and likewise with respect to unpredictability and user control). Several of the claims are also rejected under the second paragraph of the subject named statute for lacking antecedent basis. Those recitations lacking antecedent basis include: "the display screen" (claims 1, 3, 23, 25, 34, 36, and 49), "the steps" (claims 1, 3, 8, 12, 21, 34, 36, 39, and 60), "the screen" – multiple occurrences (claims 1, 3, 5, 15, 17, 23, 25, 27, 34, 36, 42, 49, 59, 63, and 66), "the computer user" (claims 1, 3, 23, 25, 34, 36, and 49), "the user's control" (claims 7, 19, 23, 29, 38, 46, 51, 63, 64, and 65), "the computer screen" (claims 2, 14, 15, and 24), "the display screen" (claim 3, 23, 25, 34, 36, and 49), "the screen" – multiple

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occurrences in most claims (claim 3, 5, 15, 17, 23, 25, 27, 34, 36, 42, 49, 59, 63, and 66), "the computer user" (claim 3, 23, 25, 34, 36, and 49), "the uppermost" (claims 3, 15, 25, 34, 42, and 66), "the application program window" (claims 3, 15, 25, and 34), "the existing image" (claims 5, 17, 49, and 59), "the generation" (claims 6 and 37), "the user's computer" (claims 6, 7, 8, 9, 12, 18, 19, 20, 28, 29, 30, 31, 32, 37, 39, 40, 45, 46, 49, 50, 51, 52, and 60), "said characters" – plural first occurrence (claims 7, 29, 38, and 39), "the user" (claim 9, 10, 40, and 61), "the content provider" (claims 10, 21, 22, 41, and 62), "the executable code" (claim 11), "the same" (claim 11), "the clients" (claim 12), "the number" (claims 13 and 22), "the duration" (claim 13), "application program" (claim 17), "the existing" (claim 17), "said control signals" (claims 18 and 19), "the basis" (claim 18), "the computers" (claim 21), "the senders" – plural first occurrence (claim 21), "the message" – multiple occurrences (claim 21), "the recipients" – plural first occurrence (claim 21), "the media" (claim 22), "the content provider's page" (claim 22), "the user's computer display" (claims 23, 25, and 49), "said media signal" (claims 26, 27, 28, 31 – plural first occurrence, 48, 49 – singular first occurrence, 50, 66, and 67), "the server" (claim 30), "the same" (claim 33), "the application program image" (claim 39), "said control signals" (claim 45), "the database" (claim 46), "the existing image" (claim 49), "the server" (claim 52), "the media signal generator" – singular first occurrence (claim 52), and "the user" (claim 61). However, in order to consider these claims in light of the prior art, examiner will assume that these features are not indefinite by having an antecedent basis from the specification.

***Claim Rejections - 35 USC § 102***

Claims 1-52 and 58-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese reference 10-222341 or Canadian Application 2,384,315. Each of the claims in the present application corresponds to claims in those examined applications by foreign patent examining agencies. The examinations by the foreign offices included in the present application filed in March 2003 and May 2003 discuss the prior art references such that the rejection discussion can be used to reject the current pending claims.

Claims 1-52 and 58-67 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The company information posted on one of the assignee web sites states that in 1999 the concept of Shoshkele was created as a technology innovation. The specification recites "advertising is presented on a computer screen in the form of an animated multimedia character that will be referred to as a 'shoshkele'." This recitation is essentially the claimed invention and has been disclosed in public use since 1999. Since the present application was filed in 2001, which is more than one year permitted under 35 USC 102(b), it is statutorily barred from being patented. It is also noted that the declaration filed in May 2003 admits that the claimed invention has been in public use for more than one year before the filing thereof. Specifically on page 3 of the Brad Meyers declaration (paper # 19), Javascript is declared to be in use since 1997 when used in conjunction with Flash programs by Macromedia. In the penultimate

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sentence of that page, numerous Javascripts scripts are available in the public domain for many purposes, including examples like those described above. It is considered that those example descriptions are the claimed invention and as such, the claimed invention was in public use since 1997 which is more than one year from the priority filing date of the present application in 1999.

***Claim Rejections - 35 USC § 103***

Claims 1-52 and 58-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of Juno Online Services (hereinafter JUNO) method of computer multimedia advertising. Since at least 1997, JUNO has performed the claimed method comprising:

introducing or displaying into a computer screen a multimedia animated character;

sending content from a server to a client and providing a tag communicating to a character controlling server (or media source); and

selecting a multimedia animated character, greeting, recipient and sending the character. Examiner also has personal knowledge of the claimed translational movement, uppermost character display on a multilayer screen, overlaying and transparent charactering, sound display, signal control generation including basis on a user computer, network connectivity and command sending, browser and HTML viewer use, executable code installed in media or file, and payment based on volume or duration access. The claimed introducing or displaying into a computer screen a

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multimedia animated character occurs when the examiner accessed JUNO's free electronic mail account in which the examiner was presented with a multimedia animated character (known as a pop-up advertisement). The claimed sending content from a server to a client and providing a tag communicating to a character controlling server (or media source) occurs when JUNO would gather demographics associated with examiner user response data to send advertisement presentations based on examiner demographic data and correlating that data to advertisers who would historically target that demographic variable data or tag. The claimed selecting a multimedia animated character, greeting, recipient and sending the character occurs when examiner would compose and send an e-mail alerting others to the pop-up advertisement provided by JUNO advertisers. The claimed invention, recited by the applicants, has been provided by JUNO long before the filing of applicants' invention except for the intrusive, unpredictable, and uncontrollable nature of the character. Examiner notes that it is old and well known to those skilled in the art of computer multimedia advertising, that it would have been obvious to claim the invention as recited by the applicants, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the intrusive, unpredictable, and uncontrollable nature of a character since the intrusive, unpredictable, and uncontrollable feature is merely non-functional descriptive language which is not functionally involved in the steps recited. The introducing or displaying into a computer screen a multimedia animated character would be performed the same regardless of the nature of the character. To one of reasonable skill in the art



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of computer multimedia advertising, most pop-up advertisements, as claimed by the applicant are intrusive, unpredictable, and uncontrollable. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to present a multimedia animated character having any type of nature because such a nature does not functionally related to the steps in the invention claimed and because the subjective interpretation of the nature does not patentably distinguish the invention. The motivation to combine applicants claimed invention with the examiner's personal knowledge of JUNO is to allow advertisers greater targeting capabilities, while transferring information more efficiently, which clearly shows the obviousness of the claimed invention.

### ***Response to Arguments***

#### *interview*

The interview conducted in January 2003 (paper # 13) reached an agreement that a demonstration of the steps including a character beyond user control while application running on the same window/ screen display with a transparency feature was unique. However the invention as claimed and arguments presented are not considered allowable for the reasons to follow.

*enablement and indefiniteness*

The arguments presented by the applicant are considered moot since the claims are rejected as being non-enabling and indefinite on the basis of the subjective interpretation of claimed features. Those features are considered non-enabling and indefinite as discussed in the rejection above.

*anticipatory*

The arguments with respect to the anticipatory rejections are moot in light of the new rejections above.

*obviousness rejection*

In response that the claimed invention is not an obvious variation of examiner's personal experience, an affidavit is submitted with this Office action. Applicant argues that the non-functional descriptive language "intrusive, unpredictable, and uncontrollable nature of the character" patentably distinguishes the invention. In the field of endeavor to which the applicant seeks to patent the claimed invention, opinions of the nature of the character data transmission do not patentably distinguish the invention from the prior art. Opinion claim language directed to an intended use which does not result in a functional or structural difference with respect to the prior art does not serve as a limitation on the claim (please see *In re Scheiber*, 44 USPQ2d 1429 (Fed.Cir. 1997)). In this case examiner considers the recited "intrusive, unpredictable,


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and uncontrollable nature of the character" to not result in a functional or structural difference with respect to the prior art and therefore does not serve to limit the claim over the prior art. Examiner's personal experience is the prior art as supported by the affidavit infra and non-functional descriptive opinion language needs not prior art support for rejection.

### ***Conclusion***

1. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicant chooses to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

<b>After-final</b>	<b>(703) 872-9327</b>
<b>Official</b>	<b>(703) 872-9326</b>
<b>Non-Official/Draft</b>	<b>(703) 872-9325</b>

  
**STEPHEN GRAVINI**  
**PRIMARY EXAMINER**

smg

August 18, 2003